Title: APPARATUS FOR TRANSMITTING AND RECEIVING EXECUTABLE APPLICATIONS AS FOR A MULTIMEDIA SYSTEM,
      AND SYSTEM TO ORDER AN ITEM USING A DISTRIBUTED COMPUTING SYSTEM

REMARKS

This responds to the Office Action dated January 6, 2012.

No claims are amended, no claims are canceled or added; as a result, claims 68-97, 99-103, 105-138, and 246-247 remain pending in this application.

The Rejection of Claims Under § 103

The U.S. Supreme Court decision of *KSR v. Teleflex* provided guidance for evaluating obviousness.

> The rationale to support a conclusion that a claim would have been obvious is that *all the claimed elements were known in the prior art* and one skilled in the art could have combined the elements as claimed by known methods *with no change in their respective functions*, and *the combination would have yielded nothing more than predictable results* to one of ordinary skill in the art.[1]

"If *any of these findings* cannot be made, then this rationale [of combining prior art elements according to known methods to yield predictable results] cannot be used to support a conclusion that the claim would have been obvious."[2]

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[1] *See KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 U.S.P.Q.2d 1385 (2007); *see also* MPEP § 2143, emphasis added.

[2] MPEP § 2143, emphasis added.

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Claims 68 - 78, 82 - 83, 85 - 94, 97 - 104, 106 - 116, 120 - 121, 123 - 132, 135 - 138 and 246 - 247 are rejected under 35 U.S.C. 103(a) as being unpatentable over Florin, U.S. patent no.: 5 583 560 in view of Tagawa, U.S. patent no.: 4 866 515.

As to the distinctions to be discussed herein, Claim 68 is illustrative and reads as follows:

A method comprising:

using a server to transmit to a client both a television program and a computing application comprising executable code, the executable code to be executed at the client to cause display of interactive information associated with the television program while the television program is being displayed at the client, the interactive information to show or describe an item to a television viewer;

detecting, at the server, a signal representing a viewer interaction with the interactive information, the viewer interaction indicating a selection of the item; and

in response to the viewer interaction, causing an order for the item to be placed.

The Office Action states that "Florin teaches using a server to transmit to a client both a television program and an application,"[3] citing Florin at column 8, lines 52-54 for support. The Applicants infer that, by referencing "an application," the Office Action references "a computing application" recited in claim 1. It is respectfully pointed out that the cited passage from Florin merely describes the A/V connect module that receives "analog audio-visual signals and digital data from a plurality of audio-visual sources, including the T/T cable 52, the video cassette recorder (VCR) 56, or the other A/V devices 57 . . ."[4] The Office Action makes no attempt to

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[3] Detailed Action, page 2.

[4] Detailed Action, page 2; Florin at column 8, lines 52-55.

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explain why the reference to mere "digital data" is considered as correlating to an application or "a computing application" recited in claim 68. The term "digital data" only appears 4 times in the Florin specification,[5] and no reference suggests that it means anything other than audio/video data in digital form; and no passage suggests a computing application.

Further, the Office Action draws a distinction that is very difficult to parse - that Florin discloses "[a computing] application,"[6] but "does not teach a computing application comprising executable code."[7] The claim limitation of "computing application including executable code" is meant to expressly establish what is inherent in the art, that a computing application that is to be executed inherently includes executable code. Otherwise, the instructions of the application would not be executable. The Office Action therefore attempts to draw a distinction that does not exist. If Florin does not disclose executable code (as admitted in the Office Action), then it does not disclose a computing application that can be executed at the client (as required by claim 68).

Further, because Florin does not teach a transmission of a computing application comprising executable code (as is correctly stated by the Office Action[8]), Florin does not disclose either any functionality of transmitted executable code or any operations dependent on that transmitted executable code functionality. However, claim 68 expressly recites both. Claim 68 recites functionality of the executable code: "code to be executed at the client to cause display of interactive information associated with the television program;" and further recites specific acts occurring in response to that functionality: "detecting, at the server, a signal representing a viewer interaction with the interactive information." Neither of these limitations is disclosed in Florin.

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[5] Florin, col. 8, line 53; col. 9, lines 15 and 39, and col. 10, line 23.

[6] Office Action, page 2.

[7] Office Action, page 4.

[8] Office Action, p. 4.

The Office Action cites Tagawa to show "executable code." Tagawa describes a service and entertainment system for transmitting video signals, audio signals and television game software signals from a central transmitting apparatus to terminal units mounted at passenger seats in a passenger vehicle such as aircraft.[9] Tagawa explains that the plurality of video signals, audio signals, and television game software signals to be transmitted are frequency-multiplexed at the transmission side and supplied through leaky cable to each terminal apparatus unit on the reception side.[10] While Tagawa discusses transmitting video signals, audio signals, and television game software signals to a terminal apparatus, Tagawa, like Florin, fails to disclose any functionality of transmitted television game software signals that may cause display of any information associate with a television program. In contrast, claim 68 expressly recites "code to be executed at the client to cause display of interactive information associated with the television program" and further recites specific acts occurring in response to the display of interactive information associated with the television program: "detecting, at the server, a signal representing a viewer interaction with the interactive information." Neither of these limitations are disclosed in Tagawa.

Thus, even assuming - solely for purposes of argument - that there could be some motivation to combine the teachings of the two references (which is not in any way conceded), combining the system of Florin (transmitting audio-visual signals and digital data) with that of Tagawa (transmitting video signals, audio signals, and television game software signals to a terminal apparatus) still fails to disclose any source transmitting both a television program and a computing application with executable instructions to a client, where the computing application is to cause display of interactive information associated with the television program. Thus, even if the combination is made, it does not disclose or suggest "using a server to transmit to a client both a television program *and a computing application comprising executable code*, t*he*

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[9] Tagawa, Abstract.

[10] Tagawa, 9: 55-62.

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*executable code to be executed at the client to cause display of interactive information
associated with the television program while the television program is being displayed at the
client,*" as recited in claim 68, and thus cannot render claim 68 and its dependent claims
obvious.[11]

Claims 87, 101, 106, 125, and their respective dependent claims, as well as claims 246-
247 are patentable for at least the reasons articulated above. Accordingly, Applicants
respectfully request reconsideration and withdrawal of the rejection of the identified claims.

Claims 79 -81, 95 - 96, 117 - 119 and 133 - 134 are rejected under 35 U.S.C. 103(a) as
being unpatentable over Florin, U.S. patent no.: 5 583 560 in view of Tagawa, U.S. patent no.:
4 866 515 in further view of Coddington, U.S. patent no.: 5 410 343.

As explained above, the combination of Florin and Tagawa fails to disclose any source
transmitting both a television program and a computing application with executable instructions
to a client, where the computing application is to cause display of interactive information
associated with the television program. Coddington, whether considered separately or in
combination with Florin and Tagawa, also fails to disclose this approach. Claims 79 -81, 95 -
96, 117 - 119 and 133 – 134 are thus patentable in view of the cited combination, at least as
being dependent on their respective base claims.

Claims 84, 105 and 122 are rejected under 35 U.S.C. 103(a) as being unpatentable over
Florin, U.S. patent no.: 5 583 560 in view of Tagawa, U.S. patent no.: 4 866 515 in further view
of Banker, U.S. patent no.: 5 485 221.

As explained above, the combination of Florin and Tagawa fails to disclose any source
transmitting both a television program and a computing application with executable instructions

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[11] *KSR v. Teleflex,* 82 U.S.P.Q.2d at 1395 (2007) ("A rationale to support a conclusion that a claim would have been
obvious is that *all the claimed elements were known* in the prior art . . .").

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to a client, where the computing application is to cause display of interactive information

associated with the television program. Banker, whether considered separately or in combination

with Florin and Tagawa, also fails to disclose this approach. Claims 84, 105 and 122 are thus

patentable in view of the cited combination, at least as being dependent on their respective base

claims.

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CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's representative at (408) 278-4052 to facilitate prosecution of this application.

If necessary, please charge any additional fees or deficiencies, or credit any overpayments to Deposit Account No. 19-0743.

Respectfully submitted,

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Date ____June 6, 2012____   By ___/Elena Dreszer/_____

Elena B. Dreszer

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